

REMARKS***Specification***

The Examiner has objected to the Specification as containing an embedded hyperlink. Applicants have amended the Specification, thereby obviating the objection.

The Examiner has further objected to the Specification as not containing an abstract as required by 37 CFR 1.72(b). Applicants point out an abstract is provided on a separate sheet as page 30 of the application. Applicants received a return postcard receipt indicating that thirty pages were received at the time of filing. Applicants can provide a copy of page 30 if the Examiner desires.

In view of the amendments and comments, reconsideration and withdrawal of the objections are respectfully requested.

Amendments to the Claims

Claims 10 and 11 have been canceled to reflect the elections made in the Reply to Restriction Requirement, filed on October 20, 2003. Claims 1, 3, 8 and 12 have been amended to correct obvious typographical and grammatical errors. No new matter has been added. Entry of the amendments is respectfully requested.

Objection to Claims 3, 8 and 12

The Examiner has objected to Claims 3, 8 and 12 as containing informalities. Applicants have amended Claims 3, 8 and 12, thereby obviating the objection. Applicants note that HA and FLAG epitopes are not abbreviations, or, are commonly listed commercially by these names. Reconsideration and withdrawal of the objection are respectfully requested.

Rejection of Claims 1-9 and 12 Under 35 U.S.C. §112, second paragraph

The Examiner has rejected Claims 1-9 and 12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention.

The Examiner rejected Claim 1 for lack of antecedent basis for the limitation "the pooled plasmid clones." Applicants have amended Claim 1, thereby obviating the rejection.

Claim 2 does not recite "the tag". Applicants recite "a tagged polypeptide" and are left unclear as to the basis of the Examiner's rejection for lack of antecedent basis. Applicants have amended Claim 3 to correct the lack of antecedent basis in that claim.

The Examiner rejects claim 5 for allegedly lacking antecedent basis for the selection of protein motifs by polymerase chain reaction. Applicants note that this is a further limitation of Claim 4 pertaining to the method of selection. As a further limitation, it correctly occurs for the first time in dependent Claim 5.

The Examiner has rejected Claim 6 for not clarifying whether EF-1 α represents a genomic DNA or a cDNA. Applicants point out that EF-1 α is a common promoter, and is clearly identified as such in the body of Claim 6. As the Examiner points out it is known that a cDNA does not have a promoter. Therefore, it is clear that EF-1 α is not a cDNA.

The Examiner rejected Claim 8 as being indefinite for including the phrase "such as" and for lacking clarity by including a parenthetical statement in step h). Applicants have amended Claim 8 to remove the phrase "such as" and the parenthetical statement, thereby obviating the rejection.

The Examiner rejected Claim 9 for lack of antecedent basis for the limitation "each pool of clones." Applicants have amended Claim 1 to provide antecedent basis, thereby obviating the rejection.

The Examiner rejected Claim 12 as being vague and indefinite because it is unclear which cell type "the cells" refers to. Applicants have amended Claim 12, thereby obviating the rejection.

In view of the amendments and above remarks, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 1-4, 8 and 9 Under 35 U.S.C. §103(a)

The Examiner has rejected Claims 1-4, 8 and 9 under 35 U.S.C. 103(a), as being unpatentable over Brent *et al.* (U.S. Patent No. 5,780,262) in view of Adamou *et al.* (U.S. Patent No. 5,811,535).

The Examiner asserts, for example, "Since Brent *et al.*, teach to culture bacteria containing the double stranded cDNA in leu^r plate and plasmids from colonies that turn blue on X-gal medium are isolated... and it is known that a single recombinant bacterial colony contains a single plasmid, Brent *et al.*, disclose culturing the bacterial cells of step a) to produce clones wherein each clone corresponds to a single tagged cDNA construct, arraying the individual bacterial clones, pooling a predetermined number of arrayed clones (ie., blue colonies on the plate) and isolating plasmid DNA from them as recited in steps c) to e) of claim 1." (pages 5-6 of the Office Action).

The MPEP states that, in order to establish *prima facie* obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." (MPEP §2143) Applicants respectfully disagree that Brent *et al.* teach pooling of clones as recited, for example, in step d) of Claim 1.

Brent *et al.* describe identifying the Mxi1 and Mxi2 proteins as proteins that interact with Max through the use of an interactive trap. The screen involves taking an expression library and isolating only those library members that demonstrate they contain a construct that encodes a protein that interacts with Max. This step is the screening step wherein a particular activity is assayed. Steps c) and d) of Claim 1 are omitted from the teachings of Brent *et al.*

To further illustrate that Brent *et al.* do not pool clonal colonies, it is stated in column 5, last paragraph, that the isolates of the interaction trap were grown on selection media and selected based on their color when grown on X-gal medium. Clonal colonies were isolated and construct DNA was sequenced to identify the results of the screen. If the clonal colonies had been pooled, direct sequencing would have been impossible as no unique sequence would have been present. Therefore, Brent *et al.* teach the use of a tagged cDNA library for isolating clones having a particular activity of interest, but nowhere do Brent *et al.* teach first dividing the tagged cDNA library into pools prior to assaying for a particular activity of interest.

Applicants further note that Adamou *et al.* do not teach the pooling of tagged cDNA clones. Therefore, the combined references do not teach or suggest all of the claim limitations.

In light of the above remarks, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claim 6 Under 35 U.S.C. §103(a)

The Examiner has rejected Claim 6 under 35 U.S.C. 103(a), as being unpatentable over Brent *et al.* (U.S. Patent No. 5,780,262) in view of Adamou *et al.* (U.S. Patent No. 5,811,535) and further in view of Wilson *et al.* (U.S. Patent No. 5,932,211).

As Applicants note above, neither Brent *et al.* nor Adamou *et al.* teach pooling clones as in step d) of Claim 1. Applicants further note that Wilson *et al.* do not teach or suggest pooling clones as in step d) of Claim 1. Claim 6 is dependent on Claim 1 and therefore includes all of the limitations of Claim 1. Therefore, the teachings of the combined references do not teach or suggest all of the limitations of Claim 6.

In light of the above remarks, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claim 6 Under 35 U.S.C. §103(a)

The Examiner has rejected Claim 12 under 35 U.S.C. 103(a), as being unpatentable over Brent *et al.* (U.S. Patent No. 5,780,262) in view of Adamou *et al.* (U.S. Patent No. 5,811,535) and further in view of Short *et al.* (U.S. Patent No. 6,057,103).

As Applicants note above, neither Brent *et al.* nor Adamou *et al.* teach pooling clones as in step d) of Claim 1. Applicants further note that Short *et al.* do not teach or suggest pooling clones as in step d) of Claim 1. Claim 12 is dependent on Claim 1 and therefore includes all of the limitations of Claim 1. Therefore, the teachings of the combined references do not teach or suggest all of the limitations of Claim 12.

In light of the above remarks, reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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Dated: April 26, 2004